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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,921	11/06/2001	Takeshi Takizawa	Q67064	4568

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EXAMINER

FOOTLAND, LENARD A

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,921

Applicant(s)

TAKIZAWA ET AL.

Examiner

Lenard A. Footland

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-27 and 45-79 is/are pending in the application.
- 4a) Of the above claim(s) 18-27, 45 and 46 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-54, 58, 60, 62, 64, 69, 73 and 77 is/are allowed.
- 6) ☒ Claim(s) 47-51, 55-57, 59, 61, 66-68, 70, 72, 74, 76, 78 and 79 is/are rejected.
- 7) ☒ Claim(s) 63, 65, 71 and 75 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5.8</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's election without traverse of the species of Fig's. 27a-b remains. Claims 18-27 and 45-46 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to non-elected species, not all claims depending upon or otherwise including the limitations of an allowed generic claim.

Applicant is reminded that if the amendment of any claims results in a change of the species they read upon, that is required to be indicated. In addition, if any new claims are added, it is required that the applicant indicate which of them read on the elected species. Failure to do so will result in a holding of nonresponsiveness.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(a) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 47-49, 56, 67 are rejected under 35 U.S.C. § 102(a), as being anticipated by Guers. The examiner finds all claimed subject matter to be present.

See Fig. 1.

Claims 50, 55, 57, 59, 61, 68, 70, 72, 74, 76, 78, 79 are rejected under 35 U.S.C. § 102(a), as being anticipated by Hofmann. The examiner finds all claimed subject matter to be present.

See Fig. 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 51 is rejected under 35 U.S.C. § 103 as being unpatentable over Hofmann as set forth in the rejection of claims 50, 55, 57, 59, 61, 68, 70, 72, 74, 76, 78, 79 above, and further in view of official notice of common knowledge in the art.

The examiner finds that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a cover since it was known in the art to do so to minimize contamination.

— Claim 66 is rejected under 35 U.S.C. § 103 as being unpatentable over Guers as set forth in the rejection of claims 47-49, 56, 67 above, and further in view of official notice of common knowledge in the art.

The examiner finds that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide vibration sensing via elasticity adjustment since it was known in the art to do so to measure vibration in a bearing environment.

Claims 63, 65, 71, 75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 52-54, 58, 60, 62, 64, 69, 73, 77 are allowed.

This application contains claims drawn to an invention non-elected with traverse. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01. Failing this, an application otherwise ready for allowance will be taken to have authorization to have such claims canceled by examiner's amendment.

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant argues at page 14 re claim 49 that Guers does not show "a circuit part ... attached to ... a ring[] along a 'circumferential direction'", and further that probe 8 is "not [a

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detecting part] connected to a circuit part that is also attached to the rolling bearing 10".

As to the first point, the wire (no reference number) connecting elements 6' and 19 is a circuit part that is in fact attached to a ring via element 6, "along a circumferential direction", which appears to be a meaningless term if not compared to some other point.

As to the second point, winding circuit 11 (col. 3, lines3-4) is a detecting part that is connected to the aforesaid circuit part both of which are attached to the rolling bearing via element 6'.

In response to Applicant's arguments, 37 CFR § 1.111(c) requires applicant to "clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections." In this case, applicant has failed to clearly point out patentable novelty and failed to show how the amendment avoids the combination of references applied against the claim.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS

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FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenard A. Footland, whose telephone number is (703) 308-2683.



Lenard A. Footland

Primary Examiner

Technology Center 3600

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laf

February 12, 2004